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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,470	02/22/2002	John H. Wynne	21529-11	8458

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EXAMINER

YAN, REN LUO

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/080,470

Applicant(s)

WYNNE, JOHN H.

Examin r

Ren L Yan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- RY 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Claims 23 and 24 are objected to for the following reasons:

In claim 23, lines 9 and 10, the recitation of "said assembly" on each line lacks proper antecedent basis, and second line from the end, the recitation of "the openings" also lacks proper antecedent basis.

In claim 24, second last line, the recitation of "the openings" lacks proper antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 8, 10, 11, 17-20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Sims(2,438,828). The patent to Sims teaches the detailed structure and method of a stencil apparatus as claimed including an elongated stencil support strip 18 defining a severance line 19 (a line of perforations) through the support strip and a stencil support area, a plurality of stencil elements with cut-out portions A and O and having pressure sensitive adhesive 23 and 23a on the lower surfaces. The stencil elements are releasably adhered on and to the stencil support area through the severance line 19 and adhesive 23. The stencil apparatus has two layers, a lower release liner 26 and 27 and an upper layer 18 which has a coating of adhesive on its lower surface. The stencil apparatus of Sims allows the release liner 26 and 27 to expose the cut-out portions of the stencil elements and the pressure sensitive adhesive underlying the upper layer, and the upper layer having an opening formed by removing the cover sheet 25

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and 22 to expose the release liner. The removed cover sheet has adhesive on its lower surface and thus can be used to provide additional masking if needed. When the stencil apparatus is mounted onto a desired surface 11, paint or other marking material can be applied through the stencil to apply an image to the surface. See Figs. 1-5 and column 1, line 45 through column 3 line 23 in Sims for details.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Aulick(2,421,825). Sims does not teach the use of masking tape to attach the stencil onto the surface being printed. Aulick teaches in a stencil apparatus the use of masking tapes 20(Fig. 1) to attach the stencil sheet onto a surface to be printed. In view of the teaching of Aulick, it would have been obvious to those having ordinary skill in the art to make use of the removed portions of cover sheet 25 having the adhesive backing as additional masking tapes to the stencil apparatus.

Claims 3, 4, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Booth(3,584,385). Sims does not teach supporting the stencil element at both the top and bottom and the guide lines. Booth teaches in a stencil apparatus a support structure for supporting both top and bottom ends of the stencil elements 16 at grooves 28(Figs. 1-4) and provides guide lines on the surface of frame member 20 for proper alignment of the stencil

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elements 16. In view of the teaching of Booth, it would have been obvious to those having ordinary skill in the art to provide the addition support for the bottom end of the stencil elements to enhance the support for the stencil elements and guide lines for proper alignment of the stencil elements.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Fexer(6,142,071). Sims does not teach the use of a masking structure on at least one end of the stencil apparatus. Fexer teaches in a stencil apparatus the use of spacer cards 22, 24 and 26 (Figs. 1A-1D) to mask the ends of the stencil apparatus. It would have been obvious to those having ordinary skill in the art to provide the stencil apparatus of Sims with end masking structure appropriately disposed as taught by Fexer in order to achieve a clean printed image.

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Lopez(4,129,669). Sims does not teach to manufacture the stencil apparatus in a roll form. Lopez teaches a stencil apparatus for use to apply a decorative design to a surface the conventional way of manufacturing the stencil apparatus in a roll form. See column 2, lines 41-50 in Lopez for example. It would have been obvious to those having ordinary skill in the art to manufacture the stencil apparatus of Sims in a roll form as taught by Lopez so as to enable the user to conveniently cut off the stencil at any desired length to print a decorative design.

Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Wagenvoord(3,665,889). Sims does not teach to use a single layer for the stencil apparatus apart from the stencil elements. Wagenvoord teaches in a stencil apparatus the conventionality of using a single layer construction for a stencil support strip 25(Fig. 1). In view of the teaching of Wagenvoord, it would have been obvious to those having ordinary skill in the

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art to provide the stencil support strip of Sims with a single layer construction so as to simplify the construction of the stencil apparatus and cut material and manufacturing cost.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sims. Sims shows in Fig. 4 a severance line to allow individual removal of release liner 26 or 27 for mounting the stencil apparatus in a desired location. To merely provide additional severance lines, such as one separating letters A and O so that either of the letters A or O can be individually printed would have been obvious to those having ordinary skill in the art.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Schlundt(5,165,337). Sims does not teach a stencil kit. Schlundt teaches a screen printing kit including a stencil 52, a stencil support 50, marking material 15 and 16, and an applicator 14. In view of the teaching of Schlundt, it would have been obvious to those having ordinary skill in the art to provide the stencil apparatus of Sims in a kit having the stencil apparatus, the marking material and the applicator in order to provide convenience to the stencil user for using the stencil apparatus.

Claim 23 appears to distinguish over the prior art of record and thus would be allowable if the above objection were overcome applicant's next response to this Office action.

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 703-308-0978. The examiner can normally be reached on 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A handwritten signature in black ink, appearing to read "Ren Yan", with a stylized flourish at the end.

Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
May 30, 2003